IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

		Atty. Docket: **KVITNITSKY=1A**
In re Application of:	)	Conf. No.: **5965**
	)	
Emma KVITNITSKY et al	)	Art Unit: **2877**
	)	
I.A. Filing Date: **04/21/2004**	)	Examiner: **N. S. CHANDRAKUMAR**
371(c) Date: **01/03/2007**	)	
	)	Washington, D.C.
U.S. Appln. No.: **10/553,757**	)	
	)	
For: **NANOPARTICLES FUNCTIONALIZED PROBES...**	)	March 23, 2009 **MONDAY**

REQUEST FOR RECONSIDEATION, AND PETITION FOR THREE MONTHS SUSPENSION

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, Mail Stop Amendments
401 Dulany Street
Alexandria, VA 22314

Sir:

Replying to the Office Action mailed October 22, 2008, petition for two (2) months' extension of time, and petition for three (3) months' suspension being filed herewith, applicants respectfully request for reconsideration for the reasons set forth below.

The claims in the application remain as claims 1-5 and 7-31 of which claims 15-31 have been withdrawn from further consideration. Applicants respectfully submit that their claims define patentable subject matter. Favorable reconsideration and allowance are respectfully urged.

Applicants hereby respectfully petition under 37 CFR §1.103(a) for a suspension of action by the PTO for three (3) months, for the following reasons. The applicants need additional time to carry out certain experiments which will produce additional experimental data showing both a complete process for the preparation of compounds of the present application, as well as significant enhancement for the efficacy of such compounds over the closest compounds disclosed in the prior art; and, in particular, the ascorbic acid derivatives of the present invention have better physical and chemical properties and are significantly more stable than those disclosed in the prior art, and to provide such data in the Declaration under 37 CFR §1.132.

As regards the maintenance of the restriction requirement and the withdrawal of claim 15-31, applicants do not understand why claim 14 is examined and maintained as elected subject matter, whereas the very similar claim 15 is withdrawn, as this makes no sense to applicants. The only difference between claims 14 and 15, both of which call for a composition, is that claim 15 contains a functional recitation as to the intended use of the composition of claim 14. It is understood that the examiner considers claim 15 to call for a composition which is especially adapted in some way, e.g. dosage, for the particular condition, disease or disorder

intended. Still, there is no reason why the generic claim 14 should be examined and the more specific claims 15-30 should not be examined, particularly claim 15 which is not directed to any specific condition, disease or disorder.

Applicants again respectfully request examination of at least claims 15-30, even if claim 31 remains withdrawn.

Claims 1-5 and 7-14 have been rejected under the first paragraph of Section 112, as purportedly failing to comply with the enablement requirement as to the full scope of the claims. This rejection is respectfully traversed.

Respectfully the present invention does not exist in a vacuum. Pages 1-6 of the present specification acknowledge a considerable body of prior art which provides a starting point for the present invention, and the PTO in the outstanding Office Action has taken the position that the claimed subject matter would have been obvious from the two cited documents, a position which, in the context of the present invention, the applicants believe and respectfully submit is inconsistent with the rejection based on lack of enablement, i.e. the present invention cannot have a disclosure which does not enable the person skilled in the art to practice the present invention and at the same time be

obvious to those of only ordinary skill in the art **without** applicants' specification as additional guidance.

As regards how to make, applicants cannot believe that the PTO really takes the position that those skilled in the art would not know how to make applicants' compounds based on common knowledge and the additional material set forth in the present specification which contains two examples of synthesis, and further explains in sufficient detail at page 16 starting with line 20, how to obtain additional compounds.

As regards how to use, one example is given which should convince those skilled in the art of the efficacy of the present invention. Those skilled in the art could, from that point, determine how to use the compounds of the present invention without undue experimentation, i.e. with only routine experimentation, and such a disclosure does meet the enablement requirements of the first paragraph of USC 112.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 1-5 and 7-14 have been rejected as obvious from either of Shimizu et al EP 0619313 (Shimizu) or Strelchler et al USP 6,143,906 (Strelchler). Both of these rejections are respectfully traversed.

Shimizu exemplifies only one compound, and applicants' compounds would not have been obvious from the one compound exemplified by Shimizu.

All the other compounds which fall within the generic disclosure of Shimizu are only set forth in a huge "basket" or "shot gun" disclosure, and the possibility of coming up with one of applicants' compounds from such a generic disclosure of Shimizu is like figuring out the combination of a safe from looking at the dial, i.e. everything is there but how to put it all together in the right combination is next to impossible.

The situation with respect to Strelchler is somewhat similar, expect that the ascorbyl sorbates of Strelchler's formula I differ importantly in a structural way from applicants' compounds at the 2 position. There is no *prima facie* obviousness because of such a difference in structure. The structure of applicants' compounds does not fall within the generic disclosure of Strelchler's formula I.

Withdrawal of the rejection is in order and is respectfully requested.

As indicated above, applicants request a suspension for a term of three months for the purposes indicated above, so that applicants can develop and present evidence supporting

applicants' arguments for patentability. Such a suspension is authorized by 37 CFR §1.103(a). A suspension for three months during which term applicants may file evidence in support of patentability is respectfully requested.

Respectfully submitted,

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